Heveafoam Asia Sdn Bhd v PF (Teknologi) Sdn Bhd

HIGH COURT (SHAH ALAM) — ORIGINATING SUMMONS NO MT3–24–797-1996

LOW HOP BING J

10 SEPTEMBER 1998

Patents *— Infringement — Anticipation and novelty — Construction of patent claims — Patents Act 1983 s 14(2) — Patents Regulations 1986 reg 12*

The plaintiff was a manufacturer of foam products since its incorporation in 1990. The defendant was the registered proprietor of Utility Innovation Certificate No MY-107563-A entitled 'Polymeric Foam products with Annular Bores' ('the defendant's UI') granted on 8 April 1996. It was filed on 31 January 1990. The defendant's UI related to foam products with annular bores extending from the surface of the foam products into the general body of the foam and was alleged to be an improvement of the conventional foam products. The defendant claimed that the plaintiff had infringed the defendant's UI. The plaintiff filed an originating summons praying, inter alia, for a declaration under ss 56 and 57 of the Patents Act 1983 ('the Act') that the defendant's UI is invalid and a declaration under s 62 of the Act that the manufacture or the export, sales, supply and distribution to third parties of the plaintiff's product do not constitute acts infringing upon the defendant's UI. It was submitted for the plaintiff that the defendant's UI lacked novelty or was otherwise anticipated by prior art. The defendant contended that the UI was novel and that it had not been anticipated by the publication of the documents viz 'US Patent No 3516901' ('the said US Patent') and Polysar Progress November-December 1983 issue. The said US Patent was a patent which related to a method of manufacturng unitary foam articles which is available to the public via the Patent Information Unit Library of Standards and Industrial Research Institute of Malaysia (SIRIM) as of April 1986. The Polysar progress is a promotional magazine which is available to the public via the Rubber Research Institute Library as of 30 January 1984.

Held, granting order in terms of the originating summons:

(1) The said US Patent and the *Polysar Progress* were in two different public libraries which are available and accessible to members of the public or people in the rubber trade or profession and constitutes disclosure to public in Malaysia. There was disclosure to the public by way of availability of the documents in the libraries accessible to the public prior to the filing date. The three pre-requisites of s 14(2) of the Act are fulfilled. Therefore, the defendant's UI was not new in Malaysia as it was anticipated by prior art (see pp 672H–I, 673B–C).

(2) The said US patent clearly described a product which fell squarely within the claim of the defendant's UI and therefore, anticipated the defendant's UI. Although the word 'corings' was used instead of 'annular bores', the effect was the same as can be seen from the illustrations of the said US Patent (see p 674H–I).

(3) Similar to the product in the defendant's claim, the product described in the article in the *Polysar Progress* was also a single piece/unit with pins extending to the foam body to produce bores/cavities. With the explanation given in the article as well as the photographs, a reader skilled in the art is able to reproduce a foam product which will fall squarely within the defendant's claim and therefore anticipates it (see p 676B, E).

(4) With respect to the said US Patent, although it dealt with a different subject matter, ie a method of production of a foam product with different foam densities, it nonetheless anticipates the defendant's UI bearing in mind that if in fact the prior art does come within the boundary of the claimed monopoly, it is immaterial that the earlier and later workers may have approached the matter from different standpoints, or used different language, in which to describe their respective contributions to the art (see p 681C–E); *The General Tire & Rubber Co v The Firestone Tyre & Rubber Co Ltd & Ors* (1972) RPC 457 followed.

(5) The purpose and meaning of the specification of the UI is to put the public in possession of the secret of the UI in as ample and beneficial a way as the patentee himself uses it. Therefore, the failure of the inventor to state the parameters such as diameter, thickness and the pattern distribution of the annular bores clearly put the secret of the UI out of the public's reach and as such ought to be invalidated on the ground of insufficiency, as it failed to comply with reg 12(1)(c) of the Patent Regulations 1986 ('the PR') in that it had failed to disclose the innovation in such terms and in a manner sufficiently clear and complete for the invention to be evaluated and caried out by a person having ordinary skill in the art (see p 685A–C).

(6) Under reg 12(1)(e) of the PR, the court found the defendant had failed to comply with the requirement thereunder in that the defendant had failed to describe the best mode contemplated by the applicant for carrying out the invention by omitting the parameters of the UI. In addition the defendant's failure to state in the description the process by which the UI was to be manufactured clearly disregarded reg 12(1)(f) of the PR as it was not obvious from the description or the nature of the alleged innovation the way in which it can be made (see p 685F–H).

(7) 'Inutility' means something which is not useful. Since the required parameters were missing in the instant case, the desired result would not be achieved. Hence, the defendant's UI was invalidated on the ground of inutility (see p 686B).

(8) The terms used by the defendant were all relative and ill-defined. For example, the term 'annular bores'. The term 'annular' is ambiguous or is wrongly used and so the defendant's UI was also invalid on ground of ambiguity (see pp 686F, 687A).

(9) The defendant's UI has been anticipated by prior publications which sufficiently teach the art found in the defendant's UI. As such, the defendant was not the rightful owner of the utility innovation. It belongs to persons who have first disclosed the said art to the public in Malaysia (see p 687C–D).

(10) The plaintiff was both an aggrieved person and an interested party. Since the process used to manufacture the defendant's UI was restricted to MY-107527-A, the court found the plaintiff's products did not infringe the defendant's UI as the process employed to manufacture the plaintiff's product was different (see p 687G–H).

[**Bahasa Malaysia summary**

Plaintif adalah pengeluar produk berbuih sejak ia diperbadankan pada tahun 1990. Defendan adalah tuan punya berdaftar Sijil Inovasi Utiliti No MY-107563-A yang dinamakan 'Produk Berbuih Polimer dengan bentuk Anulus' ('UI defendan') yang diberikan pada 8 April 1996. Ia telah difailkan pada 31 Januari 1990. UI Defendan adalah berkaitan dengan dengan produk-produk berbuih dengan bentuk anulus dari bahagian permukaan produk-produk berbuih ke bahan berbuih itu sendiri dan ia dikatakan sebagai suatu pembaharuan kepada produk berbuih konvensional. Defendan menuntut bahawa plaintif telah melanggar UI defendan. Plaintif telah memfailkan saman pemula memohon, antara lain, untuk suatu deklarasi di bawah ss 56 dan 57 Akta Paten 1983 ('Akta tersebut') bahawa UI defendan adalah tak sah dan suatu deklarasi di bawah s 62 Akta tersebut bahawa pengeluaran atau eksport, penjualan, pembekalan dan pengedaran kepada pihak ketiga akan produk-produk plaintif tidak terjumlah kepada pelanggaran UI defendan. Ia adalah dihujahkan bagi plaintif bahawa UI defendan kekurangan pembaharuan atau sebaliknya boleh dijangkakan oleh kepakaran sebelumnya. Defendan menegaskan bahawa UI defendan adalah suatu pembaharuan dan ia belum dapat dijangkakan oleh penerbitan dokumen iaitu "Paten No 3516901 US' ('Paten US tersebut') dan 'Polysar Progress' penerbitan November-Disember 1983. Paten US tersebut adalah paten yang berkaitan dengan cara mengeluarkan bahan berbuih yang disatukan yang terbuka kepada orang ramai melalui Unit Perpustakaan Maklumat Paten Institut Piawaian dan Penyelidikan Perindustrian Malaysia (SIRIM) sejak April 1986. Perkembangan 'polysar' adalah majalah promosi yang terbuka kepada orang ramai melalui Perpustakaan Institut Penyelidikan Getah sejak 30 Januari 1984.

Diputuskan, perintah seperti dipohon di dalam saman pemula:

(1) US Paten dan *Polysar Process* berada di dalam dua perpustakaan awam yang sedia ada dan boleh dimasuki oleh orang awam atau sesiapa di dalam perdagangan atau profesion getah dan terjumlah kepada pendedahan kepada orang awam di Malaysia. Terdapat pendedahan kepada orang awam melalui adanya dokumen-dokumen di dalam perpustakaan yang terbuka kepada orang awam sebelum tarikh pemfailan. Tiga pra-syarat di dalam s 14(2) Akta tersebut telah dipenuhi. Oleh itu, UI defendan bukanlah baru di Malaysia oleh kerana ia telah dijangkakan oleh seni yang terdahulu (lihat ms 672H–I, 673B–C).

(2) Paten US tersebut dengan jelas menggambarkan produk yang terjatuh sepenuhnya di dalam tuntutan UI defendan dan dengan itu, boleh menjangkakan UI defendan. Walaupun perkataan 'coring' telah digunakan dan bukannya 'bentuk anulus', kesannya adalah sama seperti yang dilihat di dalam ilustrasi Paten UI tersebut (lihat ms 674H–I).

(3) Sama dengan produk tuntutan defendan, produk yang digambarkan di dalam artikel di dalam *Polysar Progress* adalah sepotong/seunit dengan pin-pin yang meliputi bahan berbuih untuk menghasilkan bentuk (bores/cavites). Dengan penjelasan yang diberikan di dalam artikel begitu juga dengan gambar-gambar, seorang pembaca yang mahir dalam bidang tersebut boleh menghasilkan semula produk berbuih tersebut yang terjatuh sepenuhnya di dalam tuntutan defendan dan dengan itu menjangkakannya (lihat ms 676B, E).

(4) Dengan hormat kepada US Paten tersebut, walaupun ia membincangkan subjek perkara yang berbeza, iaitu suatu cara pengeluaran produk berbuih dengan kepadatan buih yang berbeza, ia telah menjangkakan UI defendan dengan mengambil kira hakikatnya bahawa seni yang terdahulu adalah termasuk di dalam sempadan monopoli yang dikatakan, ia adalah tidak material bahawa pengusaha yang awal atau kemudiannya mempunyai pendekatan ke atas perkara tersebut dari sudut yang berbeza, atau menggunakan perkataan yang berbeza, untuk menggambarkan sumbangan masing-masing kepada seni tersebut (lihat ms 681C–E); *The General Tire & Rubber Co v The Firestone Tyre and Rubber Co Ltd & Ors* (1972) RPC 457 diikut.

(5) Tujuan dan maksud spesifikasi UI adalah untuk meletakkan pihak awam berada dalam posesi rahsia UI dengan cara terbuka dan memanfaatkan oleh kerana pemegang paten juga menggunakannya. Oleh itu, kegagalan pencipta untuk menyatakan parameter seperti diameter, ketebalan dan bentuk penyebaran di dalam bentuk anulus dengan jelas meletakkan rahsia UI di luar pegangan orang awam dan dengan itu patut dijadikan tidak sah di atas dasar kekurangan, oleh kerana ia gagal mematuhi peraturan 12(1)(c) Peraturan Paten 1986 ('PP

tersebut') oleh kerana ia gagal untuk mendedahkan inovasi tersebut di dalam terma-terma dan dengan cara yang jelas dan penuh untuk rekaan tersebut dinilaikan semula dan dijalankan oleh seorang yang mempunyai kepakaran yang biasa di dalam seni tersebut (lihat ms 685A–C).

(6) Di bawah peraturan 12(1)(e) PP tersebut, mahkamah mendapati bahawa defendan telah gagal untuk mematuhi dengan keperluan di bawahnya di mana defendan gagal untuk menyatakan cara terbaik yang ditegaskan oleh pemohon untuk menjalankan rekaan tersebut dengan mengetepikan parameter tersebut daripada UI. Selain itu kegagalan defendan untuk menyatakan di dalam deskripsi proses di mana UI dikeluarkan dengan jelas tidak mematuhi peraturan 12(1)(f) PP tersebut oleh kerana ia adalah tidak jelas daripada gambaran atau bentuk inovasi yang dikatakan cara di mana ia boleh dibuat (lihat ms 685F–H).

(7) 'Inutility' bermaksud tidak berguna. Oleh kerana parameter yang diperlukan adalah tidak wujud di dalam kes ini, hasil yang dinginkan tidak akan dicapai. Dengan itu, UI defendan adalah tidak sah di atas dasar tidak 'inutulity' (lihat ms 686B).

(8) Terma-terma yang digunakan defendan adalah semuanya relatif dan tidak didefinasikan. Sebagai contoh, terma 'bentuk anulus'. Terma 'anulus' adalah tidak jelas dan digunakan secara salah dan dengan itu UI defendan adalah juga tidak sah di atas dasar tidak jelas (lihat ms 686F, 687A).

(9) UI defendan telah dapat dijangkakan oleh penerbitan yang sebelumnya yang mengajar dengan cukup seni tersebut yang terdapat di dalam UI defendan. Dengan itu, defendan bukanlah tuan punya yang betul inovasi utiliti tersebut. Ia adalah kepunyaan mereka yang telah mendedahkan dahulu seni tersebut kepada orang awam di Malaysia (see p 687C–D).

(10) Plaintif adalah pihak yang terkilan dan pihak yang berminat. Oleh kerana proses yang digunakan untuk mengeluarkan UI defendan adalah terhad kepada MY-107527-A, mahkamah mendapati produk plaintif tidak melanggar UI defendan oleh kerana proses yang digunakan untuk mengeluarkan produk plaintif adalah berbeza (lihat ms 687G–H).]

Notes

For cases on patents generally, see 10 *Mallal's Digest* (4th Ed, 1999 Reissue) paras 1019–1038.

Cases referred to

American Cyanamid Co v Berk Pharmaceuticals Ltd (1976) RPC 231 (refd)

Besalon International Limited & Ors v South Strong Industries Sdn Bhd [1997] 1 CLJ Supp 335 (refd)
C Van Der Lely NV v Banfords Ltd (1963) RPC 61 (refd)
Eastman Kodak Company's Application (1970) RPC 548 (refd)
EMI v Lissen (1939) 56 RPC 23 (refd)
General Tire & Rubber, The v Firestone Tyre & Rubber & Ors (1972) RPC 457 (folld)
Kodiak Trade, Re (1987) RPC 269 (refd)
Minerals Separation North American Corp v Noranda Mines Ltd 69 RPC 81 (refd)
Molins & Molins Machine Co Ltd v Industrial Machinery Co Ltd 55 RPC 31 (refd)
Pittsburg Plate Glass Co's Application (1969) RPC 628 (refd)
Public Prosecutor v Muhamed Bin Sulaiman [1982] 2 MLJ 320 (refd)
Ritz Hotel Ltd v Charles of the Ritz Ltd, The (1987–88) 12 IPR 417 (refd)
Same v Read Holliday & Sons Ld 29 RPC 245 (refd)
Sim Ah Song & Anor v Rex [1951] MLJ 150 (refd)
Tetra Molectric Ltd's Application (1997) RPC 290 (refd)
Vidal Dyes Syndicate v Levinstein Ltd (1966) RPC 532 (refd)

Legislation referred to

Evidence Act 1950 ss 45(1), 101
Patents Act 1983 ss 14(1), (2), (2)(a), 17, 23, 31(1), 36, 56(1), (2), (2)(a), (b), (d), 57, 62(1), (2), (5)
Patents Regulations 1986 reg 12(1)(c), (e), (f)

Wendy Lam Mei Kuan (*Ram Rais & Partners*) for the plaintiff.
SF Wong (*Shearn Delamore & Co*) for the defendant.

Low Hop Bing J:

The plaintiff's application

The plaintiff is a manufacturer of foam products since its incorporation in 1990.

The plaintiff received a cease and desist letter from the defendant dated 27 May 1996 which, inter alia, claimed that the plaintiff has infringed the defendant's Utility Innovation Certificate No MY–107563-A entitled 'Polymeric foam products with annular bores' ('the defendant's UI').

The plaintiff in this originating summons prays for the following relief:

(a) a declaration under ss 56–57 of the Patents Act 1983 ('the Act') that the defendant's UI is invalid;

(b) a declaration under s 62 of the Act that the manufacture or the export, sales, supply and distribution to third parties of the plaintiffs product,

ie Heveafoam 100% pure natural latex foam, specifically foam blocks and pillow blocks do not constitute acts infringing the defendant's UI; and

(c) an order that the defendant pay to the plaintiff the costs of this originating summons.

Unless the context shows a contrary connotation, a reference to a section is a reference to that section in the Act.

Plaintiff's capacity as an 'aggrieved person' or interested party

Section 56(1) of the Act requires that the plaintiff be an 'aggrieved person' before it can invoke the aid of the court for the necessary reliefs. There is no dispute that the plaintiff is an aggrieved person within the meaning of the Act. In the context of the Act, the expression 'aggrieved person' has not been judicially defined. However, in *Besalon International Limited & Ors v South Strong Industries Sdn Bhd* [1997] 1 CLJ Supp 335, p 351F–G, Kamalanathan Ratnam JC (now J), in a case relating to infringement of registered designs, applied the definition of the said phrase in trade mark cases, and gave a liberal construction. His Lordship adopted the approach of McCelland J in *The Ritz Hotel Ltd v Charles of the Ritz Ltd* (1987–88) 12 IPR 417, in which the expression included any person who would be or in respect of whom, there was reasonable possibility of his being disadvantaged in a legal or practical sense by the register being unrectified. Kamalanathan Ratnam JC (now J) continued as follows:

> Anyone who can show that he is in some way prejudiced by the wrongful entry qualifies as a person aggrieved.

The expression therefore includes all persons who have a real practical interest in the issue, beyond that of a mere busybody: *Re Kodiak Trade* (1987) RPC 269.

Section 62 of the Act states that 'any interested party' may request that the court declare that the performance of a specific act does not constitute infringement. There is also no dispute that the plaintiff qualified as an interested party within the meaning of s 62 of the Act as well.

The defendant's claim in UI

The defendant is the registered proprietor of the UI granted on 8 April 1996. It was filed on 31 January 1990. As no priority was claimed, the priority date of the UI is its filing date, ie 31 January 1990, which is the date at which novelty of the UI is to be judged.

Under the patent system, the state (or its personification) grants the inventor an exclusive monopoly for a limited time in his new invention in return for his disclosure of the invention so that the public at large will be able to practise the invention once the patent expires.

A As the registered proprietor, the defendant is accorded certain monopolistic rights wherein it can control certain acts as provided in s 36 of the Act for a limited period.

In order that the public does not infringe upon the registered proprietor's UI, the defendant is required to file a specification with the
B Patent Office. The specification consists of the particulars, abstract, claim, illustration and description. The monopolistic rights granted to the defendant is limited to the claim portion of the specification. Lord Russell of Killowen in *EMI v Lissen* (1939) 56 RPC 23 at p 39 described the function of the claim as follows:

> C The function of the claim is to define clearly and with precision the monopoly claimed, so that others may know the exact boundaries of the area within which they will be trespassers. Their primary object is to limit and not to extend the monopoly. What is not claimed is disclaimed. The claims must undoubtedly be read as part of the entire document, and not as a separate document; but the forbidden field must be found in the language of the claims and not elsewhere. It is not permissible, in my opinion, by reference to some
> D language used in the earlier part of the specification to change a claim which, by its own language, is a claim for one subject matter into a claim for another and a different subject matter, which is what you do when you alter the boundaries of the forbidden territory. A patentee who described an invention in the body of a specification obtains no monopoly unless claimed in the
> E claims.

The defendant in the instant case, therefore, has no monopoly unless it is asserted in the claim. The claim of the defendant's UI ('the claim') reads as follows:

> F A foam product (1) comprising a resiliently malleable foam material, with a plurality of cavities inside the body of the foam material, characterised in that the cavities (4) are annular bores extending from the surface of the foam body towards the mid-central layer of the foam body and/or towards the opposite surface of the foam body and the said foam product is a single unit without any lamination.

G *First task of the court*

'The first task of the court in any patent action is to decide exactly what monopoly the patentee has been granted.' Per Whitford J in *American Cyanamid Co v Berk Pharmaceuticals Ltd* (1976) RPC 231, at p 234, who continued as follows:

> H An understanding of the claims, a determination as to their scope — what lawyers call the construction of the claims — is necessarily the first task to be undertaken, and it must be done dispassionately. The claims should be considered without reference to the effect that the giving of any particular meaning may have on any issue of infringement, without reference to the result and effect so far as the attack on validity is concerned. The language
> I used in each claim is in the end determinative, but each claim must be considered against the background of, in the context of, the specification as a whole. The specification itself has to be considered in the context of the

> general field to skilled men in the particular field and they will read it against their knowledge of the prevailing conditions in the field at the time that the patent is granted, and against their knowledge of earlier work may have been 'done in this same field'.

Therefore, an understanding of the claim is important prior to any determination of the invalidation of the defendant's UI.

Description of defendant's UI

The defendant's UI relates to foam products with annular bores extending from the surface of the foam products into the general body of the foam and is alleged to be an improvement of the conventional foam products.

Under the description portion of the specification, the defendant lists the following disadvantages of the conventional product:

(1) Poor weight support

> ... the distance between adjacent cores (cavities) in the general body of the foam mattress is relatively narrow, resulting in poor weight support. The surface of the foam product easily sinks under slight pressure because of the large cavities in the body of the product and the smaller support structures.

(2) Bad circulation of air

> ... the smooth surface of the foam product does not facilitate good circulation of the air in and out of the foam product resulting in a discomfort to the person using the foam product.

(3) Material to be utilized

> ... foam body made of malleable, resilient foam material. Such material preferably made from conventional foam material includes natural rubber latex foam, synthetic latex foam and synthetic foam material… .

(4) Lower rate of heat transfer

> ... the top smooth surface also contributes more surface area of the foam product in contact with the body of the person lying on it. This reduces the rate of heat transfer of the body's heat as the surface acts as an insulation layer.

(5) Poor ventilation

> The continuous smooth surface also provides for poor ventilation of air in the foam product.

(6) Less support structures

> ... the presence of large cavities or voids, reduces the combined size of the support structures thereby reducing the load bearing capacity of the foam product.

(7) Limited usage

> ... can only be used on one side, that is the side with the continuous smooth surface. The side with open cores or cavities is typically placed downwards.

(8) Limited ability to fold

> … it can be bent or folded only on one side of the product, that is with the cavities inwards.

(9) Less durable

> The presence of larger cavities and thinner walls between cavities in the product reduces the period of time for which the product retains its dimensions.

(10) Inadequate support at the edge

> The walls at the peripheral edge of the conventional foam product are relatively thin ... do not provide adequate support to a person sitting at the edge.

The defendant alleges that the objective of the innovation is to overcome the abovementioned disadvantages in that the innovation shall have:

(a) better weight support characteristics;
(b) improved body heat dissipation;
(c) improved air ventilation;
(d) conveniently folded on both sides;
(e) support human body weight at peripheral edges of the product.

The defendant then goes on to describe its UI as follows:

(i) Material to be utilized

> … foam body made of malleable, resilient foam material. Such material preferably made from conventional foam material, includes natural rubber latex foam, synthetic latex foam and synthetic foam material … .

(ii) Density

> The density of the foam material is variable and is dictated by the required resiliency of the foam product.

(iii) Position of annular bores

> The position of the annular bores in relation to another is variable but is preferably spaced uniformly in a geometrical pattern.

(iv) Arrangement of the annular bores

> … wherein the annular bores are arranged when viewed in cross section, in two rows, the upper row and a lower row and where the annular bore of the upper row is along the same longitudinal axes of the annular bore of the lower row. Alternatively, the upper row of annular bores can be slightly displaced from the annular bores of the lower row, ie in alternative arrangement.

(v) Annular bores' diameter and length

> In another embodiment, (the earlier embodiment being a mattress) comprising a pillow, the arrangement of annular bores are as described before except that the diameter of the bores are relatively smaller. The number of

bores in the pillow is correspondingly increased. It is preferable that the annular bores at the conical ends at the four sides are reduced in length relative to the body of the foam product.

(vi) Peripheral edges

It is advantageous or preferable that the peripheral edge of a mattress foam product be free from annular bores so as to provide firm support at the edge to the user.

(vii) Shape of annular bores

The annular bores can be advantageously of circular cross section, or it can be of other suitable cross-section, eg circular, square, polygonal or star-shaped.

The defendant further reasons that the products made in accordance with the invention would possess the following advantages:

(i) Improved air circulation

In the mattress, pillow and cushions made in accordance with the invention, air ventilation within the foam product is greatly facilitated by the presence of annular bores which may extend vertically from the surface of the body inwards towards the opposite surface.

(ii) Increased body heat dissipation

The presence of bores at the surfaces of the foam product reduces the total surface contact between the human body and the foam surface thus improving the heat dissipation of bodily heat of the person using the foam product.

(iii) Can fold on both sides

… the presence of annular bores on both sides enables the folding of the mattress on either side which is not possible in the conventional mattress without deforming or damaging the structure of the mattress..

(iv) Can be used on both sides

An additional advantage is the possibility of use of the mattress on both sides. Both sides of the mattress can be used without any difference, thus increasing the duration of use of the mattress.

The language used by the defendant is all relative without any absolutes or a definite point of reference.

Grounds for invalidation

The plaintiff relies on grounds (a), (b) and (d) of s 56(2) of the Act as the grounds of invalidation, which reads as follows:

> The Court shall invalidate the patent if the person requesting the invalidation proves —
>
> (a) that what is claimed as a utility innovation in the certificate for a utility innovation is not within the meaning of s 17 or is excluded from the protection under s 13 or sub-s (1) of s 31;

A (b) that the description or the claim does not comply with the requirements of s 23;
(c) …
(d) that the right to the patent does not belong to the person to whom the patent belongs was granted;

Provided that the patent has not been assigned to the person to whom the
B right to the patent belongs.

The effect of the specific subsections of s 56 of the Act on which the plaintiff relies may be briefly stated as follows:

(i) s 56(2)(a) first limb: that what is claimed as UI in the certificate for a
C UI is not within the meaning of s 17 of the Act;

(ii) s 56(2)(b): that the description or the claim does not comply with the requirements of s s 23 of the Act;

(iii) s 56(2)(d) of the Act, that the right to the patent does not belong to the person to whom the patent is granted.

D

The burden of proof lies on the plaintiff: s 56(2) of the Act (see also s 101 of the Evidence Act 1950 ('the EA').)

Lack of novelty under s 56(2)(a) of the Act

E

Submission for plaintiff

It was submitted for the plaintiff that the defendant's UI lacks novelty or is otherwise anticipated by prior art.

F Contention for the defendant

The contention of the defendant is that the UI is novel and that it has not been anticipated by the publication of the documents viz 'US Patent No 3516901' ('the said US Patent') and Polysar Progress November–December 1983 Issue'.

G

Decision of the court

Invalidation of UI

H The first limb of s 56(2)(a) of the Act provides that a UI shall be invalidated if it is not within the meaning of s 17 of the Act. Section 17 of the Act defines a UI as:

> any implement, tool, product or process which is of practical utility by reason of its form, configuration, construction or composition and which is new to Malaysia

I

In other words, a UI is valid under s 17 of the Act if it fulfils two requirements, viz, it is of practical utility and new to Malaysia.

NOVELTY

Novelty is defined in s 14 of the Act (as modified by the Second Schedule), which reads as follows:

(1) A utility innovation is new to Malaysia if it is not anticipated by prior art.

(2) Prior art shall consist of —

(a) everything disclosed to the public by written publication, by oral disclosure, by use or in any other way, prior to the priority date of the application for a certificate for a utility innovation claiming the utility/innovation;

(b) the contents of a domestic patent application for a certificate for a utility innovation having an earlier priority date than the application referred to in para (a) to the extent that such contents are included in the certificate for a utility innovation granted on the basis of the said domestic application.

(3) A disclosure made under para (a) of sub-s (2) shall be disregarded—

(a) if such disclosure occurred within one year preceding the date of the application and if such disclosure was by reason or in consequence of acts committed by the applicant or his predecessor in title;

(b) if such disclosure occurred within one year preceding the date of the application and if such disclosure was by reason or in consequence of any abuse of the rights of the applicant or his predecessor in title.

In other words, under s 14(1) of the Act, a UI will not be new to Malaysia if it is anticipated by prior art as prescribed in s 14(2) of the Act. The three pre-requisites of prior art in the form of prior disclosure by way of written publication under s 14(2)(a) of the Act are:

(a) disclosure to public in Malaysia;

(b) by way of written publication; and

(c) pre-priority date ie the pro-filing date of the UI.

The said US Patent is a patent (which relates to a method of manufacturing unitary foam articles) which is available to the public via the Patent Information Unit Library of Standards and Industrial Research Institute of Malaysia (SIRIM) as of April 1986. This is verified by Pn Wan Siti Noor Wab Abdul Halim, a Patent Information Officer of the Patent Information Unit and is not disputed by the defendant.

The 'Polysar Progress' is a promotional magazine which is available to the public via the Rubber Research Institute Library as of 30 January 1984. This is verified by the Pn Fauziah bt A Rahman, the Head Librarian of the Rubber Research Institute Library. These two documents are in two different public libraries which are available and accessible to members of the public or people in the rubber trade or profession and constitutes disclosure to public in Malaysia.

Reid in his book entitled *A Practical Guide to Patent Law* (1993) at p 27 writes as follows:

> If the document is in an ordinary public library, it is undeniably available to the public. Availability is in a trade or professional library, for example, that of the Royal Society of Medicine in the case of a medical journal or of the Chemical Society in the case of a chemical journal, is in the practice normally also reckoned as enough.

There is disclosure to the public by way of availability of the documents in the libraries accessible to the public prior to the filing date.

The three pre-requisites of s 14(2)(a) of the Act are fulfilled. That being the case, I am of the view that the defendant's UI is not new in Malaysia as it is anticipated by prior art.

EVALUATION OF CONTENTS OF DOCUMENTS

The next step is to examine the contents of the said documents. In embarking upon this task, I have in mind and do hereby apply the principles enunciated in *The General Tire & Rubber v Firestone Tyre & Rubber & Ors* (1972) RPC 457. This English Court of Appeal decision clearly details the approach to be undertaken in evaluating the contents of the documents relating to patent litigation. At p 485, the Court of Appeal held, inter alia, as follows:

> In the present case, we are not concerned with anticipation by earlier use of the patentee's device but with anticipation by prior publication; that is to say, it is contended that the plaintiff's invention as claimed in their patent was at the priority date of their claim, something which was known in the United Kingdom by reason of prior publications. To determine whether a patentee's claim has been anticipated by an earlier publication, it is necessary to compare the earlier publication with the patentee's claim. The earlier publication must, for this purpose, be interpreted as at the date of its publication, having regard to the relevant surrounding circumstances which then existed, and without regard to subsequent events. The patentee's claim must similarly be construed as at its own date of publication, having regard to the relevant surrounding circumstances then existing. If the earlier publication so construed discloses the same device as the device which the patentee by his claim so construed, asserts that he has invented, the patentee's claim has been anticipated, but not otherwise. In such circumstances the patentee is not the true and first inventor of the device and his claimed invention is not new within the terms of s 32(1)(e).
>
> The earlier publication and the patentee's claim must each be construed as they would be at the respective relevant dates by a reader skilled in the art to which they relate, having regard to the state of knowledge in such art at the relevant date. The construction of these documents is a function of the court, being a matter of law, but, since documents of this nature are almost certain to contain technical material, the court must, by evidence, be put in the position of a person of the kind to whom the document is addressed, that is to say, a person skilled in the relevant art at the relevant date. If the art is one having a highly developed technology, the notional skilled reader to whom the

> document is addressed may not be a single person but a team, whose combined skills would normally be employed in that art in interpreting and carrying into effect instructions such as those which are contained in the document to be construed. We have already described the composite entity deemed to constitute the notional skilled addressee.
>
> When the prior inventor's publication and the patentee's claim have respectively been construed by the court in the light of all properly admissible evidence as to technical matters, the meaning of words and expressions used in the art and so forth, the question whether the patentee's claim is new for the purposes of s 32(1)(e) falls to be decided as a question of fact. If the prior inventor's publication contains a clear description of or clear instructions to do or make something that would infringe the patentee's claim if carried out after grant of the patentee's patent, the patentee's claim will have been shown to lack the necessary novelty, that is to say it will have been anticipated. The prior inventor, however, and the patentee may have approached the same device from different starting points and may for this reason, or it may be for other reasons, have so described their devices that it cannot be immediately discerned from a reading of the language which they have respectively used that they have discovered in truth the same device; but if carrying out the directions continued in the prior inventor's publication will inevitably result in something being made or done which, if the patentee's patent were valid, would constitute an infringement of the patentee's claim, this circumstance demonstrates that the patentee's claim has in fact been anticipated.

The said US Patent

The said US Patent relates to a method of manufacturing unitary foam rubber articles, and more particularly to such articles as mattresses, pillows, furniture cushions, automobile seat cushions, and the like. The product manufactured via this patent is a unitary article like the defendant's UI which is also a single unit without any lamination.

The said US Patent goes on to describe the prior art of its patent as follows:

> Articles of this nature are normally manufactured by the use of metal molds having upper and lower mold members, the lower member has a cavity in which the mold is partially filled with a liquid rubber latex composition that is foamable; that is, has been compounded to permit foaming. The foamed material is subsequently coagulated and vulcanized as more fully described in United States Pat No 2.432,353, one of the series of patents which describes the so-called Talalay process. The mold cavity and upper mold member contains a number of core pins which project into the pin cavity so that the resultant product has a number of corings extending inwardly from both surfaces.

The said US Patent clearly describes a product which falls squarely within the claim of the defendant's UI and therefore, anticipates the defendant's UI. Although the word 'corings' is used instead of 'annular bores', the effect is the same as can be seen from the illustrations of the said US Patent, eg Fig 3, 7 and 9.

A comparison between the wordings of the claim and the US said Patent is as follows:

The defendant's claim	*The said US Patent*
A foam product (1) comprising a resiliently malleable foam material, with plurality of cavities inside the body of the foam material	A liquid rubber latex composition that is foamable
Characterised in that the cavities (4) are annular bores	The mold cavity and upper mold member contain a number of core pins which project into the pin cavity
Extending from the surface of the foam body towards the mid-central layer of the foam body and/or towards the opposite surface of the foam body	so that the resultant product has a number of corings extending inwardly from both surfaces.
And the said foam product is a single unit without any lamination	The invention relates to a method of manufacturing unitary foam rubber articles

The illustrations of the said US Patent in eg Fig 3, 7 and 9 clearly show a product which is similar to the defendant's UI. A visual comparison is sufficient to highlight the similarities. Fig 1, 2, 3, 6 and 7 of the defendant's specifications show illustrations similar to the said US Patent.

In para 14 of the affidavit affirmed by Mr Yap Keng Lib (the innovator of the defendant's UI), he stated, for the defendant, as follows:

> Products made by the Talalay Pincore process however invariably display bores on both upper and lower surfaces of the product, hence these products are fully reversible. This is a consequence of the Talalay mould design which of necessity requires arrays of pins on both surfaces to facilitate heat transfer during the freezing stage of the Talalay cycle.

As the said US Patent utilizes the Talalay process, in my view, the product made from the said US Patent falls within the defendant's claim. Hence, the said US Patent anticipates the defendant's UI.

'Polysar Progress'

The relevant article in the promotional magazine '*Polysar Progress*' is entitled '*Dunlop invented latex foam; continues as world leader*'.

The article describes the Pincore process, also known as the Talalay Process (named after its inventor, Joseph Talalay) as well as the Dunlop process.

The article describes the Pincore process as follows: A

> The Pincore process is best suited to the manufacture of large quantities of articles with relatively simple shapes, and for very soft items such as pillows, which can be mounded in one piece. (Pillows made by the Dunlop process require two piece construction, the parts being joined with adhesives). With the Pincore system, the foam construction and characteristics are homogenous throughout the article, although the pin diameter and spacing can be changed to vary the hardness characteristic across a mattress. Mattress blocks can be fully reversible… . B

Similar to the product in the claim, the product described in the above article is also a single piece/unit with pins extending to the foam body to produce bores/cavities. C

The other important disclosures found in this article are:

(i) the centre photograph depicting the Pincore process which clearly shows the upper and lower pin mould members whereby the pins extend to the foam body and;

D

(ii) the top right corner photograph depicting a slab of latex foam mattress which clearly shows a product with cylindrical bores extending from both surfaces towards at least the opposite surface of the foam body.

In my view, with the explanation given in the article as well as the photographs, a reader skilled in the art is able to reproduce a foam product which will fall squarely within the defendant's claim and therefore, anticipates it. E

Expert evidence

F

Section 45(1) of the Evidence Act 1950 ('EA') provides for the admissibility of an expert's opinion, when eg the court has to form an opinion upon a point eg of science, the opinions upon that point of persons specially skilled in that science are relevant facts, and such a person who is specially skilled is an 'expert'.

While an expert must be skilled, he need not be so by special study, he may be so by experience; and the fact that he has not acquired his knowledge professionally goes merely to weight and not to admissibility: *Public Prosecutor v Muhamed Bin Sulaiman* [1982] 2 MLJ 320. G

The business of an expert witness is to draw upon the store of his knowledge and experience in order to explain some matter which his experience should qualify him to understand. He is quite entitled to express his opinion, which indeed is the natural corollary of his explanation. But a bare expression of his opinion has no evidential value at all. Unless he gives an explanation which supplies understanding of the subject which the court lacks, the court is in no better position than it was before to determine, and if the court acts upon a bare expression of the expert's opinion, the determination of the question becomes that of the expert and not that of the court: *Sim Ah Song & Anor v Rex* [1951] MLJ 150. H I

Having stated the principles relating to the admissibility of the opinions of experts, it is now necessary to examine the affidavits affirmed by the following persons on behalf of the plaintiff.

(i) Mr Alan Hodgson Laird;

(ii) Pn Titi Dolai;

(iii) Mr Goh Kok Thai; and

(iv) Mr Koo Pai Sing

Mr Alan Hodgson Laird was registered as a patent agent in the United Kingdom under the Patents Act 1949 on 11 September 1968. He was elected a Fellow of the Chartered Institute of Patents Agents on 22 January 1969, and was entered on the first list of professional representatives before the European Patent Office as of 17 January 1978. He has been continuously in practice as a patent agent either in corporate practice or in private practice since 1968, and has been continuously a member of the above institutions from the time of joining.

Puan Titi Dolai holds a bachelor's degree in Chemical Engineering from the Pittsburg University and has been continuously in practice as a Research Officer at the Patent Information Unit since April 1992.

Mr Goh Kok Thai holds a bachelor's degree in Applied Science (specialization in Polymer Science and Technology) (First Class Honours) from the Universiti Sains Malaysia and possesses practical experience in the production of latex and latex products since 1982.

Mr Koo Pai Sing obtained a bachelor's degree in Chemical Engineering in 1965 and a diploma from the Institution of Rubber Industry in 1970.

He holds numerous professional qualifications as listed in his curriculum vitae which is exhibited in his affidavit as well as possesses practical working experience in the art since 1967.

In my view, each of the abovementioned professionals qualifies as a reader skilled in the art, and I accept them as experts under s 45(1) of the EA.

Mr Allan Hodgson Laird gave his opinion by studying the defendant's UI, the *Polysar Progress* and the said US Patent. His conclusions are that the defendant's UI is invalid because it relates to an innovation which is anticipated by prior art and that the claim cannot be amended to make it valid.

He lists the three main features of the defendant's UI as follows:

(i) the cavities are annular bores extending from the surface of the foam body towards the mid central layer of the foam body and/or;

(ii) towards the opposite surface of the foam body; and

(iii) the foam product is a single unit without any lamination.

He then explains certain terms and expressions found in the defendant's UI namely:

(i) Annular Bores

> This term might mean that the cross-section of the bores should be in the form of an annulus. However the term may simply be equivalent to 'cylindrical bores'. The term is used consistently throughout the specification and used specifically to describe the bore (4) shown in fig 1 and also in other Figures illustrating the invention. These bores are in the form of simple cylinders and so this term is taken to mean no more than cylindrical bores.

(ii) Extending... towards... the mid central layer

> This expression raises the question as to whether the bores as well as extending towards the mid central layer can also extend through that layer.
>
> The specification from p 4 line 18 to p 5 line 2 states that according to the present invention, the annular bores 'extend substantially vertically from the external surface of the foam body to mid central layers of the foam body'. This expression is different from that used in the claim but throughout the specific description of the illustrated embodiments of the invention, the annular bores are said to extend towards the inner central plane of the foam body. The illustrations of the invention do not show any annular bores extending through the central layer.
>
> While the rights of the certificate owner should not be limited to the specific embodiments of the foam product described in the specification, the whole tenor of the document is that the annular bores should extend towards a particular place rather than through it.

(iii) And/or towards the opposite surface of the foam body

> This expression raised the question as to whether the annular 'bores may extend up through and even pass through the opposite surface of the foam body. Following the reasoning set out above in relation to annular bores extending towards the mid central layer, it is concluded that this expression means that the annular bores may, in addition or as an alternative, extend in the direction of the opposite surface but not up to or through the opposite surface of the foam body'.
>
> The purpose of the defendant's UI is to obviate problems inherent in the conventional foam product.'.

He then examines the validity of the defendant's UI in relation to the:

(i) conventional products;

(ii) *Polysar Progress;* and

(iii) said US Patent.

With respect to the conventional products, Mr Laird opines as follows:

> From the specifications, conventional products are acknowledged to have a structure in which cavities extend from one surface of the foam body towards the opposite surface but do not reach it.
>
> Such conventional products are also said in the specification to have relatively narrow foam columns between the cavities.

The claim is not limited to any particular size and accordingly since the claim includes a foam body in which the cavities are annular bores extending towards the opposite surface of the foam body, the conventional products described and illustrated in the specification possess this feature.

The claim also requires that the foam product should be a single unit without lamination. The description of conventional products in the specification includes mattresses which are not laminated and it illustrates unlaminated products.

Accordingly the claim is anticipated by the prior art conventional products described in the specification.

The description of the conventional products set out in the specification is consistent with foam products made by the Dunlop process.

With respect to the products made by the Pincore process, Mr Laird opines as follows:

> '*Polysar Progress*' November/December 1983
> This document includes an article entitled '*Dunlop invented latex foam; continues as world leader*'. The article refers to the Pincore process noting that the pin diameter and spacing can be changed to vary the hardness characteristics across the mattress. The article includes a picture of a Pincore press and also a picture of a foam mattress made by the Pincore system. It is evident from the picture that the foam product produced has annular bores extending from the surface of the foam body, but it is not entirely clear whether or not the bores stop before the mid central layer or whether they extend towards the opposite surface. From the photograph of the mattress, it is not clear whether or not such bores might extend right through the whole of the foam body.
>
> Nevertheless, the balance of probability is that this article discloses a foam product with annular bores extending from the surface of the foam body at least towards the opposite surface.

With respect to the said US Patent, Mr Laird observes:

> This patent relates to a method of manufacturing: unitary foam rubber articles, particularly mattresses, pillows and the like.
> The illustrations show clearly a foam rubber article with cavities extending from both the upper and lower surface towards the mid central area but not extending through that area.
>
> The invention described in US Patent 3516901 is the insertion of boundaries so that materials of different properties may be moulded on each side of the boundary. The document makes it clear that the previously known processes did not have such boundaries and were single units.
>
> The disclosure in US Patent 3516901 is remarkably similar to that in the Utility Innovation. Figures 3 and 9 of US Patent 3516901 are essentially the same as the illustrations of the invention shown in Fig 1, 2 or 3 of the Utility Innovation.

He concludes as follows:

> The claim in the Utility Innovation is clearly anticipated by the disclosure in US Patent 3516901 in respect of a foam product in which the annular bores

> extend towards, but do not pass through, the mid central layer of the foam body, and by the article in *Polysar Progress* in so far as the annular bores extend towards the opposite surface of the foam body.

Mr Laird also considered whether an amendment to the claim is possible in order to avoid infringement, but found that it was not possible. His reasons are as follows:

> The certificate owner has indicated that a disadvantage of the conventional products is the relatively large size of the cavities compared to the area between the cavities. However the specification provides no indication whatever as to dimensions which would overcome this apparent disadvantage. Accordingly the certificate owner cannot amend the claim to introduce such dimensions.

The certificate owner might consider amendment of the claim to limit it to foam products in which the cavities extend from the surface of the foam body towards, but do not reach the mid central layer of the foam body. Such an amendment may possibly avoid anticipation by the Pincore process on the basis that it is usual for the pins to overlap in the mid central layer. However the resulting claim is still anticipated by the product described in US Patent 3516901.

No other significant amendment appears to be available to the certificate owner and accordingly the claim cannot be amended to make it valid'.

Puan Titi Dolai's opinion is based solely on the comparison between the defendant's UI and the said US Patent, and opines as follows:

> In determining a novelty of a patent or a utility innovation patent, only one document is considered and on this ground, we found that the US-A-3516901 is the most relevant document related to the above said Malaysian Utility Innovation (UI) patent.

From the foregoing claim, the foam product of a resiliently malleable foam material is actually a unitary foam rubber article as mentioned in the specification of US-A-3516901 (p 1, line 24).

Further described in the above claim, the foam product comprises annular bores that extend from the upper and lower surfaces of the foam product towards its central part. In accordance to this, the rubber product in the description of the US-A-3516901 also described such product as having the same characteristic, whereby it is explained by the resultant product has a number of corings extending inwardly from both surfaces (p 1, lines 37–39) wherein the meaning of both surfaces herein is the top and the bottom surfaces of the product (p 1, lines 36–37).

The Malaysian Utility Innovation ('MUI') patent also claimed that its product is a single unit without any lamination. Taking a definition of lamination as 'laminated structure or material especially of layers fixed together to form rigid or flexible material' in the *Concise Oxford Dictionary* (9th Ed), it is understood that the product as claimed in the MUI patent does not consist of layers. Therefore, it is a single or unitary article as mentioned in the US-A-3516901 patent (p 1, lines 23–39).

The teaching of the method as explained by the US-A-3516901 patent also resulted in a product that has corings or bores extending from the upper and bottom surfaces of the product towards its central part. This description also covers the product as claimed in claim 1 of the MY 107563 patent. Since the US-A-3516901 patent is granted on 23 June 1970, earlier than the filing date of the MUI patent, the said US patent then is a prior art to the teaching of the MUI patent.'.

Mr Goh Kok Thai concurs with the expert opinions of Mr Laird and Pn Titi Dolai.

The above experts are of the opinion that the description of conventional products in the defendant's UI specification itself, the said US Patent and the '*Polysar Progress*' anticipate the claim. The claim is worded such that it encompasses the foam product with annular bores extending from one surface and not restricted to annular bores extending from both surfaces of the foam body.

In my judgment, with respect to the said US Patent, although it deals with a different subject matter, ie a method of production of a foam product with different foam densities, it nonetheless anticipates the defendant's UI bearing in mind what was held in *General Tire*, that if in fact the prior art does come within the boundary of the claimed monopoly, it is immaterial that the earlier and later workers may have approached the matter from different standpoints, or used a different language in which to describe their respective contributions to the art.

This objectivity is neatly illustrated in *Molins & Molins Machine Co Ltd v Industrial Machinery Co Ltd* 55 RPC 31. The patent involved related to high speed cigarette making machines of so-called 'continuous rod' type, in which the tobacco showered down vertically onto a moving web.

To eliminate the known problem of 'piling up' of the tobacco on the web, the patentee had the idea of imparting to the falling tobacco a forward component of movement also, so that the tobacco met the web at an acute angle rather than at right angles. The prior art specification of Bonsack, dated some 48 years earlier, related only to low speed machines of this type; in these machines, the piling up problem did not arise at all. Bonsack's machine did, however, contain an inclined trough which would have the incidental effect of imparting a forward component of motion. In these circumstances, it was held that Bonsack was not concerned in the slightest with the problem that Molins had solved.

The plaintiff's case before me is stronger because clearly the defendant's so called improved product is described as the prior art product in the said US Patent. Further, the product produced in the said US Patent also anticipates the defendant's UI as it falls squarely in the defendant's claim.

In *Pittsburg Plate Glass Co's Application* (1969) RPC 628, the ancitipatory material was a claim filed earlier than the applicant. It was held that although the earlier claim is directed to a product produced by a particular process, and the later claim is directed to the process which gives rise to the product, this is no barrier to establishing anticipation.

Similarly, in the plaintiff's case before me, although the said US Patent relates to a process or method in which a single foam body with different densities is produced, it is no barrier to a claim of anticipation with respect to the product that the said process actually produces. With respect to the photographs found in the '*Polysar Progress*' magazine which anticipates the defendant's UI, I am mindful of the House of Lords judgment in the case of *C Van Der Lely NV v Banfords Ltd* (1963) RPC 61 which succinctly states, inter alia, that photographs can, in appropriate circumstances, anticipate a patent or in this case, a utility innovation.

In this context, Mr Goh Kok Thai is of the opinion that the said photographs clearly show a foam product which is precisely the foam product claimed in the defendant's UI. Further, Mr Goh states that 'a person with relevant practical experience in latex foam production will be able to reorientate and/or modify his production process to produce a product which will fall squarely within the claim, given its [the claim] vagueness and ill-definition'.

In addition, I am giving due consideration to Mr Laird's opinion as this case involves a utility innovation in which the requirement of an inventive step is obviated. Moreover, the defendant's UI revolves around an uncomplicated foam product which is clearly seen in the *Polysar Progress* article.

In the circumstances, I hold that the defendant's UI lacks novelty or is anticipated by the prior publications highlighted by the plaintiff.

Insufficiency, inutility and ambiguity: Section 56(2)(b)

Plaintiff's submission

It was submitted for the plaintiff that the description or the claim in the defendant's invention does not comply with the requirements of s 23 of the Act in that the defendant has not complied with the Patents Regulations 1986 ('the PR'), by reason of insufficiency, inutility, ambiguity and unfair basing.

Defendant's reply

It was argued for the defendant that the UI contains clear and precise information which a person skilled in the art of latex foam manufacture can understand what is disclosed in the UI and then perform it.

Decision of the court

Compliance with s 23 of the Act

Section 56(2)(b) provides that it is a ground for invalidation if the description or the claim does not comply with the requirements of s 23 of the Act.

Section s 23 of the Act provides as follows:

> 23 Requirements of application.
>
> Every application for the grant of a patent shall comply with the regulations as may be prescribed by the Minister under this Act'.

More specifically, it is incumbent upon the defendant to comply with the requirements prescribed in reg 12(1)(c), (e) and (f) of the PR, failing which, the plaintiff would be in a position to raise insufficiency for the purpose of invalidating the defendant's UI.

Insufficiency

Under reg 12(1)(c), (e) and (f) of the PR:

> (1) The description shall first state the title of the invention as appearing in the request and shall:
> (c) disclose the invention in such terms that it can be understood and in a manner sufficiently clear and complete for the invention to be evaluated and to be carried out by a person having ordinary skill in the art, and state any advantageous effects of the invention with reference to the background art;
> (e) describe the best mode contemplated by the applicant for carrying out the invention, using examples where appropriate and referring to the drawings, if any; and
> (f) indicate implicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is industrially applicable and the way in which it can be made and used or, if it can only be used, the way in which it can be used.

It was explained by the English Court of Appeal in *Tetra Molectric Ltd's Application* (1997) RPC 290 that 'if you cannot achieve the promised result because of deficiencies in the information given in the specification, there is insufficiency'. Insufficiency, in my view, means something which is insufficiently described. In *Vidal Dyes Syndicate v Levinstein Ltd* (1966) RPC 532; *Same v Read Holliday & Sons Ld* 29 RPC 245, at p 265, the English Court of Appeal emphasized the importance of a sufficient description as follows:

> Two duties are incumbent upon a patentee in preparing his complete specification. In the first place, he must particularly describe and ascertain the nature of the invention, and, in the second place, he must particularly describe and ascertain in what manner the same is to be performed.

At p 127, the English Court of Appeal continued:

> It is settled law that a patentee must act towards the public *uberrima fide*, and must give the best information in his power as to how to carry out the invention. He is therefore bound to tell the public all the steps that can advantageously be taken in carrying out the invention.

Applying the provisions of reg 12(1)(c), (e) and (f) of the PR and also the principles enunciated in *Vidal Dyes*, I am of the view that the defendant has

not complied with the requirements under reg 12(1)(c), (e) and (f) of the PR. It is not possible to understand the invention from the defendant's description, much less to achieve the advantageous effects of the innovation.

Mr Goh Kon Thai, who fulfils the qualification of being a person having ordinary skill in the art, opines as follows:

> Though the above specification [the defendant's specification] attempts to explain the Utility Innovation, it does not state the parameters that are important to produce the desired result. These parameters include:
>
> (i) The maximum diameter of the annular bores. Annular bores above certain diameters will not produce the desired effect.
>
> (ii) The maximum/minimum thickness of the foam blocks with annular bores which will produce an effective result.
>
> (iii) The pattern of distribution of the annular bores on the surfaces and the distance between the bores.

As alluded to above, the terms used in the defendant's description are relative with no fixed points of reference.

In many instances, the defendant has compared its innovation with conventional products. In my view, the comparison to the conventional product is not a good reference point because there are no fixed parameters for the so called conventional product to begin with.

On the other hand, Mr Yap Keng Lib's affidavit, in support of the plaintiff's case, contains para 4(a)(i), (ii), (iii) and (vi) with these passages:

> The said disadvantage is overcome by producing a product that has smaller cavities compared to the conventional product and in turn having larger and firmer support structure.
>
> Due to the plurality of cavities on the foam material, the above shortcomings are resolved.
>
> Yet another disadvantage is the reduction of the load bearing capacity of the foam product due to the presence of large cavities. This problem is solved again by having cavities smaller than that of the conventional products.
>
> Yet another disadvantage is that it if relatively less durable due to the large cavities and thinner walls between cavities. Since the present invention has wider support structures comparatively, it will remain in place since the load bearing capacity of the product is higher.

Mr Yap Keng Lib, by using relative adjectives and general terminology, apparently has admitted to the insufficiency of the specification of the defendant's UI. The absence of an accurate and precise statement on parameters leaves one to a guessing game on the relative values which surely vary from one person to another. The comparisons to so called 'conventional products' cannot seriously be taken as giving an accurate point of reference as the so called 'conventional products' have no uniform parameters but varies from product to product.

Furthermore, nowhere in the specification of the UI are the parameters for the 'conventional products' stated.

In my view, the purpose and meaning of the specification is to put the public in possession of the secret of the UI in as ample and beneficial a way as the patentee himself uses it. Therefore, the failure of Mr Yap Keng Lib as the inventor to state the parameters such as diameter, thickness and, the pattern distribution of the annular bores clearly puts the secret of the UI out of the public's reach and as such ought to be invalidated on the ground of insufficiency, as it fails to comply with reg 12(1)(c) of the PR in that it has failed to disclose the innovation in such terms and in a manner sufficiently clear and complete for the invention to be evaluated and carried out by a person having ordinary skill in the art.

An analogy may be drawn from *Eastman Kodak Company's Application* (1970) RPC 548. There, in opposition proceedings, the specification claimed a solid highly crystalline polypropylene having a tensile strength from 5,500 psi up to an unlimited value, stiffness from 180,000 psi up to an unlimited value. The description told the reader no more than would enable him, using the preferred process, to get a modest increase over prior art polypropylenes in relation to limiting the melting point and stiffness. The opponents contended, inter alia, that the claims went farther than was justified by the disclosure and that the specification did not sufficiently and fairly describe the invention or the method by which it was to be performed. The hearing officer took the view that the objection went no further than an objection of wide and speculative claiming and that it was accordingly not open to an opponent under s 14 of the Act.

On appeal by the opponents to the Patents Appeal Tribunal, Whitford J held that an application could be rejected, on the basis of insufficiency, where claims were broad and indeterminate and of a speculative character. The description of the invention and the method by which it was to be performed was insufficient, and the opposition on that ground succeeded.

Under reg 12(1)(e) of the PR, I find that the defendant has failed to comply with the requirement thereunder in that the defendant has failed to describe the best mode contemplated by the applicant for carrying out the invention by omitting the parameters of the U1.

In addition, the defendant's failure to state in the description the process by which the UI is to be manufactured clearly disregarded reg 12(1)(f) of the PR, as it is not obvious from the description or the nature of the alleged innovation the way in which it can be made.

INUTILITY

Inutility comes from the requirement of 'practical utility' as found in s 17 of the Act being the other requirement of a utility innovation besides being new to Malaysia. Further, reg 12(1)(f) of the PR also makes an implied reference to the innovation being 'industrially applicable'.

The English Court of Appeal in *Tetra Molectric Ltd's Application* (1977) RPC 290 explained that when you follow deficient or insufficient information and having achieved mechanically that which the specification promises you will achieve by so following it, but the end product will not of itself achieve that promise, then that is inutility.

Essentially, in my judgment 'inutility' means something which is not useful. Since the required parameters are missing in the instant case, as alluded to above, the desired result will not be achieved. Hence, the defendant's UI is invalidated on the ground of inutility.

Ambiguity

The concept of ambiguity is derived from the requirement in reg 12(1)(c) of the PR that the description shall, inter alia, disclose the invention in such terms that it can be understood and in a manner sufficiently clear.

Ambiguity is explained by Lord Reid in the Privy Council case of *Minerals Separation North American Corp v Noranda Mines Ltd*, 69 RPC 81, at p 92 as follows:

> The law as to ambiguity is clear, and their Lordships need only to refer to a well known passage in the speech of Lord Lorebum in *Natural Colour Kinematograph Coy Lt v Bioschemes Lt* (1915) 32 RPC 256, where he says: 'it is the duty of a patentee to state clearly and distinctly, either in direct words or by clear and distinct reference, the nature and limits of what he claims. If he uses language which, when fairly read, is avoidably obscure or ambiguous, the patent is invalid, whether the defect be due to design, or to carelessness or to want of skill. Where the invention is difficult to explain, due allowance will, of course, be made for any resulting difficulty in the language. But nothing can excuse the use of ambiguous language when simple language can easily be employed, and the only safe way is for the patentee to do his best to be clear and intelligible.

It is my specific finding that the terms used by the defendant are all relative and ill-defined. For example, the term 'annular bores'. The definition given in the *Webster's New Twentieth Century Dictionary of the English Language Unabridged* for the adjective 'annular' clearly indicates something having the form of a ring. Thus, 'annular bores' would mean a cavity which is ring-like and not merely a cylindrical cavity with nothing in the middle. This was highlighted in Mr Laird's opinion and was disputed by the defendant as follows:

> Yap Keng Lib, 24 April 1997, p 15:
>
> 6 With reference to p 2 of 'AHL', Alan defines 'Annular Bores' as stated in the claim as no more than 'cylinder bores'. I wish to challenge his definition as it is clearly stated in p 7 from line 12–14 or fig 8 of MY-107563 A that the Annular Bores can actually be of suitable cross-sectional pattern for example circular, square, polygonal or star shaped.
>
> Alan Hodgson Laird, 16 May 1997 at p 183:
>
> 6 In relation to para 6, I agree that the bores may have a cross-section other than circular. My use of the term 'cylindrical bores' was not intended to

> limit the cross-section of the bore other than to exclude a bore in the form of a ring containing a column of foam along the central axis of the bore.

In my view, the term 'annular' is ambiguous or is wrongly used, and so the defendant's UI is also invalid on the ground of ambiguity.

Defendant not the rightful owner: Section 52(2)(d) of the Act

Section 56(2)(d) of the Act provides that if the patent does not belong to the person to whom the right to the patent was granted, the patent can be invalidated. It is trite law that if the patentee's claim has been anticipated, the patentee is not the true and first inventor of the device: (See *General Tire & Rubber v Firestone Tyre & Rubber & Ors* (1972) RPC 457 (CA)

The defendant's UI in the case before me has been anticipated by prior publications which sufficiently teach the art found in the defendant's UI. As such, the defendant is not the rightful owner of the utility innovation. It belongs to persons who have first disclosed the said art to the public in Malaysia.

Non-infringement

The plaintiff's second prayer is for a declaration of non-infringement under s 62 of the Act. The relevant provisions are contained in sub-ss (1), (2) and (5) of the 62 of the Act which are reproduced below:

> (1) Subject to sub-s (4), any interested person shall have the right to request, by instituting proceedings against the owner of the patent, that the court declare that the performance of a specific act does not constitute an infringement of the patent.
>
> (2) If the person making the request proves that the act in question does not constitute an infringement of the patent, the court shall grant the declaration of non-infringement.
>
> (5) Proceedings for a declaration of non-infringement may be instituted together with proceedings to invalidate the patent, except where invalidation of the patent is requested under sub-s (3) of s 60.

As alluded to in my judgment above, the plaintiff is both an aggrieved person and an interested party. Since the process used to manufacture the defendant's UI is restricted to MY-107527-A, I am of the view that the plaintiff's products do not infringe the defendant's UI as the process employed to manufacture the plaintiff's product is different. The process claimed in MY-107527-A utilises closed moulds. The plaintiff's process to produce its foam products utilises open moulds as described in the schedule of the originating summons (encl 1) and as such, there is no infringement.

Further, as the defendant's UI is invalid, the plaintiff does not infringe any utility innovation.

Conclusion

On the foregoing grounds, I make an order in terms of the plaintiff's originating summons in encl (1).

Order in terms of the originating summons granted.

Reported by Jafisah Jaafar